

REMARKS/ARGUMENTS

The rejections presented in the Office action dated July 16, 2010 (hereinafter Office action), have been considered but are believed to be improper. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Applicant respectfully traverses each of the § 103(a) rejections, each of which is based upon the teachings of U.S. Patent No. 7,240,831 to Hepworth *et al.* (hereinafter “Hepworth”), because Hepworth does not teach or suggest each of the asserted claim limitations. For example, Hepworth has not been shown to teach or suggest a radio frequency tag including software instructions relating to an operation described in the manual and associated with said radio frequency tag, as claimed in each of the independent claims. Hepworth teaches that an ID tag may include an instruction to form a logical connection between an ID tag reader and a particular computing device and to send subsequently read data to the computing device via this connection (Col. 6, lines 2-8). However, there is no teaching or suggestion that the asserted printable document including the ID tag of Hepworth describes the forming of the connection and sending of the data (asserted as corresponding to the claimed operation relating to the software instructions). The claims recite that the software instructions relate to an operation described in the manual, but none of the asserted references has been shown to teach or suggest this.

Hepworth also has not been shown to teach or suggest a plurality of radio frequency tags attached on the pages of the user manual such that each radio frequency tag is readable without interference from other radio frequency tags in the user manual, as claimed in each of the independent claims. Notably, the Office action is silent with respect to these limitations, thereby failing to assert that any portion of Hepworth corresponds. In addition, although Back (U.S. Patent No. 6,655,586) teaches a plurality of page identifying tags, there is no teaching or suggestion in Back that the page identifying tags are attached such that each page identifying tag is readable without interference from other radio frequency tags.

Further Hepworth has not been shown to teach or suggest a user manual associated with the electronic device (including the reader), as claimed in the independent claims. There is no teaching or suggestion that the printable document of Hepworth is a user manual associated

with the ID tag reader 104. Rather, Hepworth suggests that the printable document is a catalog of products (Col. 1, lines 53-54). Without a presentation of correspondence to each of the claimed limitations, each of the § 103(a) rejections is improper.

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); and moreover, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). *See, e.g.*, MPEP § 2143.03. The limitations directed to at least a radio frequency tag including software instructions relating to an operation described in the manual and associated with said radio frequency tag appear to have been ignored and are not taught by the cited references. Without a presentation of correspondence to each of the claimed limitations, the § 103(a) rejection is improper, and Applicant accordingly requests that the rejection be withdrawn.

Dependent claims 6, 7, 13, 16, and 27 depend from independent claims 1 and 15, respectively. Each of these dependent claims also stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hepworth. While Applicant does not acquiesce to any particular rejections to these dependent claims, including any assertions concerning descriptive material, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the above remarks made in connection with the independent claims. These dependent claims include all of the limitations of their respective base claims and any intervening claims and recite additional features which further distinguish these claims from the cited references. “If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious.” MPEP § 2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent claims 6, 7, 13, 16, and 27 are also patentable over Hepworth.

With respect to the § 103(a) rejections of various dependent claims based upon the above-discussed teachings of Hepworth as modified respectively by the teachings of Hoshino, Back, and Landt, Applicant respectfully traverses. As discussed above, Hepworth fails to correspond to at least the radio frequency tags including software instructions relating to an operation described in the manual claimed in each of independent claims 1 and 15. The further

reliance on these additional references does not overcome the above-discussed deficiencies in Hepworth since none of these references has been shown to teach or suggest radio frequency tags as claimed. Thus, the asserted combinations of the teachings of Hepworth with the additional references do not teach each of the limitations of claims 8-11, 14, 17-20, and 26, and the rejections should be withdrawn.

With particular respect to the rejection of dependent claims 8 and 17, Applicant further traverses because the Office action has not presented correspondence to each of the claimed limitations. These claims require that the device operation (executed in the electronic device in response to reading a radio frequency tag) proceeds to a next step when a predefined or user-adjustable time has elapsed. The assertions that Hepworth fails to read tags within a predetermined time and that Hoshino teaches a reading mode for reading tags in a predetermined time fail to provide any correspondence to the claimed device operation proceeding to a next step. Without a presentation of correspondence to each of the claimed limitations, the § 103(a) rejection of at least these claims is improper. Applicant accordingly requests that the rejection be withdrawn.

With particular respect to at least the rejection of dependent claims 18 and 19, Applicant further traverses because the Office action has not presented correspondence to each of the claimed limitations. These claims require that the reader is configured to add a software code portion read from a radio frequency tag to an existing code base in the device (claim 18) and to replace an existing software code portion in the device with software code portion read from a radio frequency tag (claim 19). The assertion that RF tags may be added to a document and a reader needs to be updated to deal with them fails to provide correspondence to the claimed adding or replacing of software code in a device with software code that has been read from a radio frequency tag. Notably, the Office action fails to provide any citation or evidence in support of the rejection. Without a presentation of correspondence to each of the claimed limitations, the § 103(a) rejection of at least these claims is improper. Applicant accordingly requests that the rejection be withdrawn.

It should be noted that Applicant does not acquiesce to the Examiner's statements or conclusions concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, common knowledge at the time of Applicant's invention, officially

noticed facts, and the like. Applicant reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

In addition, the independent claims have been amended to indicate that at least one radio frequency tag includes software instructions relating to an operation described in the manual and associated with said radio frequency tag. Support for this change may be found, for example, in the original claim 1. The claim language has also been amended to more explicitly recite the already present limitations. These changes do not, and are not intended to, affect the scope of the claims. Also, claims 16-20 have been amended to change the word "arranged" to "configured". None of these changes are made for reasons related to the asserted references, and each of the claims is believed to be patentable over the asserted references for the reasons set forth above.

Also, new claims 28 and 29 have been added. Support for these claims may be found in the original specification, for example, at page 2, lines 8-13; therefore, the claims do not introduce new matter. Each of these claims is believed to be patentable over the asserted references for the reasons set forth above.

Authorization is given to charge Deposit Account No. 50-3581 (IHN.065.WUS) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the Examiner is invited to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
8500 Normandale Lake Blvd., Suite 320
Minneapolis, MN 55437
952.854.2700

Date: October 18, 2010

By: /Erin Nichols Matkaiti/

Erin Nichols Matkaiti
Reg. No. 57,125